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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,842	08/02/2001	Dirk Winne	7310-257	5668
9629	7590	02/08/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			MILIA, MARK R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,842

Applicant(s)

WINNE, DIRK

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed September 3, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figures 2 and 3 elements (21) and (23). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds one paragraph and is more than 150 words. Correction is required. See MPEP § 608.01(b).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Portable Printing System with Print Unit Detachable from Printer Base Station.

5. The disclosure is objected to because of the following informalities: Page 1, paragraph 3, line 1 reads "Application No. ____". No application number has been given. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner what is meant by line 2 of the claim, in particular "one data item having a value that varies in consecutive images". Also, line 3 of the claim states "an said sequence in a predefined manner and said information communicated", which Examiner believes to be a typographical error, renders the claim unclear.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6092941 to Imai as cited on Information Disclosure Statement dated January 16, 2004.

Regarding claim 1, Imai discloses a printing system comprising a printer unit having a housing in which a print head is mounted for movement over a print face defined by the housing and a base station arranged to receive said printer unit (see Fig. 1, column 4 lines 44-47, and column 5 lines 12-16), said base station having an opening for receiving an image receiving medium (see Fig. 1 and column 4 lines 44-52), said opening being located within said base station such that at least a portion of said image receiving medium received within said opening is adjacent said print face (see Fig. 1 and column 4 line 44-column 5 line 11), wherein a printing operation can be executed when said printer unit is received in said base station (see Fig. 1 and column 5 lines 12-16).

Regarding claim 10, Imai discloses the system discussed in claim 1, and further discloses wherein said printer unit comprises a print head cleaning station adjacent said print face whereby in response to a print head cleaning signal said print head may be brought into contact with said cleaning station to clean said print head (see column 5 lines 36-46 and column 7 lines 31-53).

Claims 11-18 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5920684 to Hastings et al.

Regarding claim 11, Hastings discloses a method of selecting a symbol to be printed by a printer unit from a set of symbols, said set of symbols comprising a plurality of subsets of symbol types, each subset comprising a plurality of symbols of one type, the method comprising sequentially displaying a first symbol from one or more of said

subsets of symbol types and selecting a said subset when a desired symbol type is displayed (see Figs. 4 and 9, column 13 lines 42-61, and column 13 line 63-column 14 line 9), sequentially displaying the symbols comprising said selective subset and selecting a desired symbol to be printed (see Fig. 9, column 13 lines 42-61, and column 13 line 63-column 4 line 25).

Regarding claim 12, Hastings discloses the method discussed in claim 11, and further discloses wherein at least one of said subsets comprises a plurality of alphabetic characters (see Fig. 11, column 5 lines 47-60, and column 7 line 60-column 8 line 4).

Regarding claims 13 and 29, Hastings discloses the method discussed in claims 11 and 12, and further discloses wherein at least one of said subsets comprises a plurality of numeric characters (see Fig. 11, column 5 lines 47-60, and column 7 line 60-column 8 line 4).

Regarding claim 14, Hastings discloses the method discussed in claim 11, and further discloses wherein at least one of said subsets comprises a plurality of special characters including a number of punctuation symbols and a number of mathematical symbols (see Fig. 9 and column 14 lines 1-9).

Regarding claim 15, Hastings discloses the method discussed in claim 12, and further discloses wherein each of said alphabetic subsets comprises a plurality of symbols, each symbol being a different representation of the same alphabetic character (see Fig. 4 and column 8 line 64-column 9 line 45).

Regarding claim 16, Hastings discloses the method discussed in claim 11, and further discloses wherein said sequential display steps are performed in response to the

operation of one or more scroll keys located on said printer unit (see Fig.1, element (63) and column 9 lines 31-33).

Regarding claim 17, Hastings discloses the method discussed in claim 16, and further discloses wherein two of said scroll keys are provided, a first scroll key causing the sequential display steps to be formed in a first sequence and a second scroll key causing the sequential display steps to be formed in a second sequence (see column 12 lines 15-29).

Regarding claim 18, Hastings discloses the method discussed in claim 11, and further discloses wherein said selecting operations are executed by the activation of a select key located on said printer unit (see Fig. 1, element (62), column 9 lines 19-22, and column 14 lines 10-13).

Claims 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5832331 to Yoshida et al.

Regarding claim 19, Yoshida discloses a printing system comprising a printing unit connected to a print processor (see Fig. 4), said print processor arranged to generate a sequence of images to be printed (see column 2 lines 50-54 and column 3 lines 41-48 and 57-59), said printing unit comprising a communication unit operable to communicate to said print processor information relating to the previously printed image (see column 4 lines 51-65) whereby said print processor is further operable to store said communicated information in a memory unit wherein if printing of said sequence of

images is interrupted printing can be resumed at the point in the sequence at which the interruption occurred (see column 4 lines 3-18).

Regarding claim 20, Yoshida discloses the system discussed in claim 19, and further discloses wherein said sequence of images includes at least one data item having a value that varies in consecutive images in said sequence in a predefined manner and said information communicated from said printing unit to the print processor comprises the value of said at least one data item (see column 4 lines 31-40 and 51-65).

Regarding claim 21, Yoshida discloses the system discussed in claim 19, and further discloses wherein said information communicated from said printing unit to the print processor comprises the number of images in said sequence that have been printed (see column 3 lines 41-48 and column 4 lines 34-40 and 51-53).

Regarding claim 22, Yoshida discloses the system discussed in claim 19, and further discloses wherein said communication unit communicates said information to the print processor after each of said images has been printed (see column 4 lines 58-65).

Regarding claim 23, Yoshida discloses the system discussed in claim 19, and further discloses wherein said communication unit communicates said information to the print processor whenever printing is interrupted (see column 4 lines 51-65).

Claims 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5923763 to Walker et al.

Regarding claim 24, Walker discloses a printing system comprising a printing unit connected to a print processor (see Fig. 1, column 4 lines 49-67, and column 7 lines 48-51), said print processor arranged to generate an image to be printed (see column 7 lines 48-51 and column 10 lines 21-34), said printing unit comprising a communication unit operable to communicate to said print processor timestamp information when said image is printed (see column 7 lines 18-47, column 8 lines 8-12, and column 10 lines 21-34).

Regarding claim 25, Walker discloses the system discussed in claim 24, and further discloses wherein the processor inserts said communicated timestamp information into said generated image (see column 7 lines 18-51, column 8 lines 8-12, and column 10 lines 28-32).

Regarding claim 26, Walker discloses the system discussed in claim 24, and further discloses wherein said processor stores said communicated timestamp information as an associated file to said generated image (see column 6 lines 30-57).

Regarding claim 27, Walker discloses the system discussed in claim 24, and further discloses wherein said timestamp information comprises the date when said image is printed (see column 5 line 63-column 6 line 12).

Regarding claim 28, Walker discloses the system discussed in claim 24, and further discloses wherein said timestamp information comprises the time when said image is printed (see column 5 lines 34-41).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai as applied to claim 1 above, and further in view of U.S. Patent No. 5570962 to Suzuki et al. as cited on Information Disclosure Statement dated June 18, 2003.

Regarding claim 2, Imai does not disclose expressly wherein said base station comprises a sensor arranged to provide a detection signal in response to an image receiving medium being placed within said opening.

Suzuki discloses wherein said base station comprises a sensor arranged to provide a detection signal in response to an image receiving medium being placed within said opening (see column 6 lines 1-15 and 27-31).

Regarding claim 3, Imai does not disclose expressly wherein in response to said detection signal said printer unit executes a printing operation.

Suzuki discloses wherein in response to said detection signal said printer unit executes a printing operation (see column 6 lines 27-31).

Regarding claim 4, Imai discloses wherein a printing operation is executed after a predefined time period (see column 6 line 54-column 7 line 3).

Imai does not expressly disclose executing the printing operation a predefined time after a detection signal is provided.

Suzuki discloses a detection signal sent to the printer after a detection of an image receiving medium (see column 6 lines 1-15 and 27-31).

Regarding claim 8, Imai does not disclose expressly wherein said base station comprises an alignment device having alignment guides whereby alignment of the said image receiving medium in said opening with said alignment guides facilitates alignment of said image receiving medium with said print face.

Suzuki discloses wherein said base station comprises an alignment device having alignment guides whereby alignment of the said image receiving medium in said opening with said alignment guides facilitates alignment of said image receiving medium with said print face (see column 3 lines 49-59 and column 4 lines 25-34).

Imai & Suzuki are combinable because they are from the same field of endeavor, miniaturized printers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the detection sensor for detecting an image receiving medium and alignment guide of Suzuki with the system of Imai.

The suggestion/motivation for doing so would have been to provide printing only when the receiving medium is correctly positioned and only when an image receiving medium is actually present.

Therefore, it would have been obvious to combine Suzuki with Imai to obtain the invention as specified in claims 2-4.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai and Suzuki as applied to claim 2 above, and further in view of U.S. Patent No. 5634730 to Bobry.

Regarding claim 5, Suzuki discloses a detection signal (see column 6 lines 1-15 and 27-31).

Imai and Suzuki do not disclose expressly where in response to said detection signal a confirmation signal is provided to indicate that a printing operation may be manually initiated.

Bobry discloses where in response to said detection signal a confirmation signal is provided to indicate that a printing operation may be manually initiated (see column 4 lines 9-19 and column 6 lines 7-12, reference teaches a photosensor used to detect if the apparatus is correctly positioned adjacent to the medium at which point a signal is sent to the microprocessor noting the proper positioning and then a display can be used to output messages such as status information and prompting a user for information, therefore the reference is analogous to the claim).

Regarding claim 6, Imai and Suzuki do not disclose expressly wherein said confirmation signal is a visual signal.

Bobry discloses wherein said confirmation signal is a visual signal (see column 4 lines 9-19, column 6 lines 7-12, and 44-46).

Regarding claim 7, Imai discloses a buzzer for alerting a user when a maintenance operation needs to be executed (see Fig. 4, column 6 line 49, and column 7 lines 31-53).

Imai and Suzuki do not disclose expressly a confirmation signal.

Bobry discloses a confirmation signal (see column 6 lines 7-12 and 44-46).

Imai, Suzuki & Bobry are combinable because they are from the same field of endeavor, miniaturized printers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the confirmation signal of Bobry with the system of Imai and Suzuki.

The suggestion/motivation for doing so would have been to provide printing only when a medium is properly adjacent to the apparatus for printing and a display signal is output so that printing cannot occur if an image receiving medium is not present (see column 4 lines 9-19 of Bobry).

Therefore, it would have been obvious to combine Bobry with Imai and Suzuki to obtain the invention as specified in claims 5-7.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imai and Suzuki as applied to claim 8 above, and further in view of U.S. Patent No. 5685651 to Hayman et al.

Suzuki discloses an alignment device having an alignment guide for paper (see column 3 lines 49-59 and column 4 lines 25-34).

Imai and Suzuki do not disclose expressly wherein said alignment device comprises at least two alignment guides whereby each of said alignment guides facilitates alignment of a different sized image receiving medium.

Hayman discloses alignment means for alignment of an envelope (see column 2 lines 29-32 and 47-50).

Imai, Suzuki & Hayman are combinable because they are from the same field of endeavor, miniaturized printers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the envelope alignment means of Hayman with the system of Imai and Suzuki.

The suggestion/motivation for doing so would have been to provide the ability to print correctly onto different size recording media to eliminate the need for dedicated printers for a particular size medium and thus decrease cost and production time.

Therefore, it would have been obvious to combine Hayman with Imai and Suzuki to obtain the invention as specified in claim 9.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show state of the art refer to Notice of References Cited.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (703) 305-1900. The examiner can normally be reached M-F 8:00am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (703) 305-4712. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
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